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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,411	06/30/2003	Scott Manzo	017516-009700US	2194

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PATENT DEPT
INTUITIVE SURGCAL. INC
950 KIFER ROAD
SUNNYVALE, CA 94086

EXAMINER

VRETTAKOS, PETER J

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 01/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,411

Applicant(s)

MANZO ET AL.

Examiner

Peter J. Vrettakos

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19, 49 and 50 is/are pending in the application.
- 4a) Of the above claim(s) 20-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19, 49 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

The action is **final**. The Applicant's amendments have necessitated new rejections.

The application is published application number: 2004/0267254.

The Applicant is requested to check the beginning of the Specification with the Bib Data Sheet to ensure that the two lists the same priority information.

Pending claims are 1-47 and 49-50. Elected claims are 1-19. Claims 49-50 are newly added. **Claims 1-19 and 49-50 are rejected below.**

A response to notice of non-compliant amendment was filed 11-10-05. The Applicant alleges to have unsuccessfully attempted numerous times to reach Examiner Pollard. However, the Examiner of Record as indicated at the top of the Applicant's own correspondence is Examiner Vrettakos, who does not know Examiner Pollard, nor his/her Art Unit location. Examiner Vrettakos has not received any phone messages from the Applicant in this case at any time.

All prior rejections are obviated.

The drawings submitted 6-30-03 are informal.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

Claim 19 recites the limitation "the first layer" in the fourth line. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 13-19, and 49-50 are rejected under 35 U.S.C. 102(b) as being anticipated by anticipated by Crow et al. (5,662,647) (teaching reference).

Crow discloses a disposable end effector (figure 2) with a RF (electrosurgical) electrode (60; hook), an insulative sleeve (44, fig. 2), a fluid inhibiting (see patented claim 2) internal sealing o-ring (38), a coupling mechanism/attachment (42) with threading (31, figure 3) and latches (depicted in figure 2 toward the proximal end of element 42, also 92 and 94 in figure 11), a gripping member (48), a plastic (Teflon col. 6:45) insulation layer (30), and a transmission member (36).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-19 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellman et al. (5,630,812) (teaching reference) in view of Crow et al. (5,662,647) (supporting reference).

Ellman et al. discloses an end effector device, however, does not expressly disclose a sealing ring.

The supporting reference discloses in a device analogous to that in the teaching reference, a sealing ring (38 – described above).

The **motivation** to combine the patents would have been to prevent fluid inflow as posited in Crow patented claim 2.

Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the teaching reference Ellman in view of the supporting reference Crow by including into the Ellman end effector device, a sealing ring to prevent fluid inflow.

Ellman discloses an end-effector device (see figure 1) for use with an electrosurgical instrument (80-10-8, col. 4:13-16) the end-effector device comprising:

- at least one active electrode (74) ("wire loop", col. 5:15-18) at a distal end of the device;
- removable coupling mechanism (58-24-22) adjacent a proximal end of the device for coupling the device with the electrosurgical instrument;
- at least one insulation sleeve (44, col. 3:29-32) disposed at least partially around the active electrode for inhibiting conduction of electrical current from the active electrode to the electrosurgical instrument;
- the sleeve having threading (58, col. 3:37) for attachment with complimentary threading (22, col. 3:36-38) on a mating component (16) permanently attached to the distal end of the shaft (10, see figure 5);
- an electrical connector (24, col. 3:23-24) within (fully assembled Ellman invention) the sleeve (44) for electrical connection with a transmission member (60) via a gripping member (20, the protrusion 20 permits the electrosurgical instrument which includes 80-10-8 and 16 as shown in figure 5 to "grip" element 44) of the mating component (16);
- and at least one insulation material (44) disposed at least partially around the hook ("wire loop", col. 5:15-18) or spatula for inhibiting conduction (when the Ellman device is not tightly screwed together) of electrical current from the active electrode to the electrosurgical instrument;

wherein the coupling mechanism comprises an electrical (conductor 24 between electrode 74 and electrical cable 60) attachments (24, col. 3:23; 60, col. 3:40-41);

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wherein the coupling mechanism comprises an electrical connector (74 rests in bore 38 of conductive element 24) on the proximal end of the device (74) for electrical connection with a transmission member (60) via a gripping member (20, the protrusion 20 permits the instrument which includes 80-10-8 and 16 as shown in figure 5 to “grip” element 44) of the electrosurgical instrument;

wherein the coupling mechanism comprises an electrical connector (24) on the proximal end (rests in bore 38) of the device (74) and an electrical tab (created by bore 28) on the proximal end of the electrical connector (24) for electrical connection with a transmission member (60) via an electrical platform of the electrosurgical instrument; the end-effector device is disposable (col. 22-23); and

wherein the coupling mechanism provides for permanent coupling (soldering at 64 in figure 2; col. 3:44) of the device with the electrosurgical instrument (includes cable 60).

Response to Arguments

Applicant's arguments with respect to claims 1-19 and 48 have been considered but are moot in view of the new ground(s) of rejection. (All prior rejections are obviated. The rejections did not sufficiently address the sealing ring, which is now a pivotal limitation in both of the application's independent claims (1, 49)).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J. Vrettakos whose telephone number is 571-272-4775. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pete Vrettakos
January 14, 2006


ROY D. GIBSON
PRIMARY EXAMINER